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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,411	10/21/2003	Gary O. Maupin	05500-00073-USC PM00028-C	5949
23416	7590	04/06/2006	EXAMINER SMITH, KIMBERLY S	
CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899			ART UNIT 3644	PAPER NUMBER
DATE MAILED: 04/06/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/690,411

Applicant(s)

MAUPIN ET AL.

Examiner

Kimberly S. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4 and 6-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 6, 7, 9-19 and 21-27 is/are rejected.
- 7) ☒ Claim(s) 8 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see remarks, filed 11/10/05, with respect to public use have been fully considered and are persuasive. The rejection of the claims 1-4, 6-27 under 35 USC 102(b) public use or sale has been withdrawn. As the Applicant's representative has stated that the devices placed on Mason's Island were for experimental purpose and there is no evidence or suggestion that commercial exploitation, either explicit or incidental has occurred, the rejection is withdrawn. However, with respect to Applicant's arguments filed 04/18/05, these arguments are not found persuasive. The Applicant has argued that the Talley patent is an apparatus that is designed to treat household pets, such as dogs and cats and that it is many orders of magnitude larger than the devices described in the present application. This is not found persuasive. It is noted that rodents, either hamster, mice, rats, etc. are notoriously well known as being household pets. Further, while specific size requirements of the device have not been claimed, it has been held that a change in size is generally recognized as being within the level of ordinary skill in the art. It is noted that the allowance of claims in applications 09/595,034 and 10/282,853 are not germane to the instant application and as such, the argument is not found persuasive. As such, the rejection as stated on 11/18/04 is maintained.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4, 10, 11, 16, 17 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Talley, US Patent 5,027,747.

Talley discloses an apparatus for applying a chemical comprising an enclosure (35) having a peripheral opening (28) including an applicator (20) comprising a flexible web (30) having a chemical on the web wherein the web comprises a fabric, wherein the applicator includes an upper horizontal support member (24), wherein the fabric includes at least one opening extending from an edge of the fabric opposite the horizontal member (i.e. the space located adjacent each wicking member (30)) having a dimension smaller than the rodent (i.e. as the members are abutting each other, the distance is consistent with being less than that of a rodent); wherein the fabric includes vertical slits extending from an edge of the fabric opposite the horizontal support member; wherein the support beam is provided across the passageway for holding the applicator and the web is arranged to engage and be suspended from the support beam; wherein the applicator has an adhesive strip along an upper edge (32) for adhering to the top wall of the enclosure. Note that adhesive is defined as "tending to remain in association". As the strip (32) allows the applicator to tend to remain in association with the top wall of the enclosure, it meets the limitation of an adhesive strip.

4. Claims 1, 9, 10, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Crawford, US Patent 987,433.

Crawford discloses an apparatus for applying a chemical comprising an enclosure having an opening including an applicator (C) comprising a flexible web having a chemical on the web wherein the passage includes a slot (C') for receiving ends of a support member (B') and

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suspending the web across the passage; wherein there is provided a support beam (B') across the passageway for holding the applicator.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 7, 12-15, 18, 19 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talley, US Patent 5,027,747.

Talley discloses the invention substantially as claimed. However, Talley does not disclose the web is semi-circular or triangular in shape. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the opening of any shape, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. Reference Pinkalla et al., US Patent 5,542,463 for basis of known modifications in web openings.

Regarding claim 12, Talley discloses an enclosure (35) having at least one peripheral opening (as viewed in Figure 3) and at least one inner wall located inside the enclosure, an inner chamber (i.e. the area into which the animal passes) which is at least partially defined by the inner wall and which is accessed by an opening in the inner wall, a passageway (28) leading from the opening to the opening in the inner wall (i.e. the passageway is defined as the thickness of the structure 35 with the opening in the enclosure being the exterior opening and the opening

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in the inner wall being the interior opening). Talley further discloses at least two applicators (i.e. each wick defining an applicator). However, Talley does not disclose the applicators located between the openings. It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the applicators between the openings, since it has been held rearranging parts of an invention involves only routine skill in the art.

Regarding claim 13, Talley discloses at least three applicators.

Regarding claims 14 and 15, Talley discloses the invention substantially as claimed but does not positively disclose the animals for which the device is to be used. It would have been obvious to design the device of Talley for the rodent being a mouse as such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

Allowable Subject Matter

7. Claims 8 and 20 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly S. Smith whose telephone number is 571-272-6909. The examiner can normally be reached on Monday thru Friday 10:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kimberly S Smith
Examiner
Art Unit 3644

kss


MICHAEL J. CARONE
SUPERVISORY PATENT EXAMINER